

### REMARKS

This Application has been carefully reviewed in light of the Final Office Action dated August 13, 2008 ("Office Action"). Claims 1-8, 10, 11, 26 and 27 are pending in the application. The Examiner rejects Claims 1-8, 10, 11, 26 and 27. Applicant respectfully requests reconsideration and allowance of all pending claims.

#### Claim Rejections - 35 U.S.C. § 103

The Examiner rejects Claims 1-8, 10, 11, 26 and 27 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,177,964 B1 issued to Birleson, et al. ("*Birleson*"), in view of U.S. Patent No. 7,196,737 B1 issued to Fulga, et al. ("*Fulga*"). Applicant respectfully requests reconsideration and allowance of all pending claims.

Applicant respectfully requests the Examiner to withdraw the *Birleson-Fulga* combination as improper. Each of the cited references, *Birleson* and *Fulga*, specifically teach away from relevant aspects of Claim 1. "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). (M.P.E.P. § 2141.02).

In the Examiner's response to Applicant's previous arguments, the Examiner states that "it was known to filter down or not the number of channels in a receiving system." See Office Action, p. 2. The Examiner then states "if a person of ordinary skill in the art can implement a predictable variation and would see the benefit of doing so a [sic] obviousness rejection likely bars it's [sic] patentability." See Office Action, p. 2 (emphasis added). Applicant asserts that a person of ordinary skill in the art would not implement this variation of *Birleson* because *Birleson* explicitly rejects this modification as being a source of error, as explained below.

As noted in Applicant's previous response, *Birleson* explicitly teaches away from "a filter operable to receive an input signal comprising a first number of television channels and further operable to communicate an intermediate output signal comprising a second number of television channels less than the first number of television channels," as recited, in part, in Claim 1. *Birleson* states, "filter 101 passes all channels in the television band" (col. 7, ll. 61; emphasis added), and "[i]n operation, the front end of tuner 10 receives the entire television band through filter 101 and amplifier 102" (col. 8, ll. 40-41; emphasis added). Thus, *Birleson*

explicitly teaches away from elements of Claim 1. Like *Birleson*, *Fulga* also teaches away from elements of Claim 1. In particular, *Fulga* actually cites to *Birleson* and states, “the input filter 101 is **not** tuned to select a few channels but instead passes **all** channels in the television band.” (Col. 2, ll. 66-67; emphasis added).

Additionally, *Birleson* describes the reason why it does not filter the input signal:

To accomplish this, an architecture was chosen to perform an up-conversion of the RF input signal to a higher internal frequency, which allows the present invention to have minimal filtering on the input stages of the receiver. The present invention is therefore able to operate without variable-tuned input filtering. **This eliminates the need for precisely controlled variable tuned filters** which must be mechanically aligned during manufacture and are subject to variation in performance due to age, temperature, humidity, vibration and power supply performance. **This was a critical drawback of previous tuners that had to be eliminated** because it is a source of tremendous error and distortion, as well as complexity.

The present invention allows a wide band of frequencies to enter the front end of the tuner circuit without removing frequencies in an input band pass tracking filter.

*Birleson*, Col. 3, lines 9-24 (emphasis added).

Therefore, as discussed above, *Birleson* not only teaches away from using “a filter operable to receive an input signal comprising a first number of television channels and further operable to communicate an intermediate output signal comprising a second number of television channels less than the first number of television channels,” as recited, in part, in Claim 1, but also explicitly rejects an input filter as a solution. Thus, a person skilled in the art would not see the benefit of this variation, as claimed by the Examiner. As both of the Examiner’s references teach away from the claimed invention, the *Birleson-Fulga* combination is improper and the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103. For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claim 1.

The Examiner makes similar improper rejections of the remaining dependent and independent claims. Applicant respectfully traverses all the rejections made in this Office Action. For at least the reasons set forth above with respect to Claim 1, Applicant respectfully requests reconsideration and allowance of Claims 2-8, 10-11, and 26-27.

**CONCLUSION**

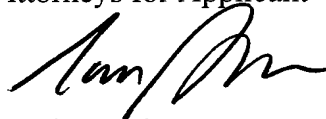
Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of all pending claims.

If there are matters that can be discussed by telephone to further the prosecution of this Application, Applicant invites the Examiner to call the undersigned attorney at (214) 953-6581 at the Examiner's convenience.

Applicant believes that no fees are due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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